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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,625	03/03/2000	Yoshinori Murata		5929

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HOGAN & HARTSON L.L.P.  
500 S. GRAND AVENUE  
SUITE 1900  
LOS ANGELES, CA 90071-2611

EXAMINER

PARK, CHAN S

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/518,625

Applicant(s)

MURATA, YOSHINORI

Examiner

CHAN S. PARK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4,6 and 9-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 12-20 is/are rejected.
- 7) ☒ Claim(s) 4,6 and 9-11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/10/05 has been entered.

### ***Response to Amendment***

2. Applicant's amendment was received on 5/10/05, and has been entered and made of record. Currently, **claims 1, 3, 4, 6 and 9-20** are pending.

### ***Response to Arguments***

3. Applicant's arguments with respect to **claims 1, 3, 4, 6 and 9-20** have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

The following quotations of 37 CFR 1.75(a) is the basis of objection:

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

4. Claims 1, 3 and 12 are objected to under 37 CFR 1.75(a) as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention or discovery.

The claims recite "document input means for obtaining an image comprising a plurality of pages to be transmitted". It is uncertain as to whether there is a special image appearing on one page. Examiner kindly suggests the applicant to amend the claim as "document input means for obtaining a page of an image comprising a plurality of pages to be transmitted". Further, appropriate correction is required for the rest of the claims to have clear antecedent basis for each terms.

5. Claim 11 is objected to because of the following informalities:

Line 2, "the second page" should be -- a second page --.

6. Claim 18 is objected to because of the following informalities:

Line 2, "an amount" should be -- the amount --;

Line 3, "a predetermined value" should be -- the predetermined value --.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 3 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite that the control means "appends a message to a document page transmitted last". It is uncertain as to whether the message is appended after the page is transmitted. It is questionable as to how the message can be appended to the document page that is already been transmitted. Does the receiving terminal append the message to the document page transmitted last? If so, examiner respectfully requests the applicant to point out the support for this feature in the Specification.

8. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 12 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the Drawings. In that paper, applicant has indicated that appending a message is performed when the storing of the image data is interrupted and this indicates that the invention is different from what is defined in the claim(s) because claim recites that appending a message is performed when obtaining the image in step (A) is interrupted. It is understood that the obtaining an image from a document is to be interpreted as scanning of a page of a image to be transmitted.

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Further, it is clear that the applicant's invention is related to the interruption that is related to the memory capacity. Thus, examiner suggests amending the claim as "if storing an additional page of an image is interrupted" at the end of the claim. Again, appropriate correction is required for the rest of the claims to have clear antecedent basis for each terms.

### ***Allowable Subject Matter***

9. **Claims 1, 3, 4, 6 and 9-11** would be allowable if rewritten or amended to overcome the objection and the rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al. U.S. Patent No. 5,892,587 (hereinafter Okada) in view of Saito et al. U.S. Patent No. 6,618,749 (hereinafter Saito).

10. With respect to claim 12, Okada teaches a communication method comprising the steps of:

- a. obtaining a page of an image from a document comprising a plurality of pages (figs. 2 & 3);
- b. storing at least a first page of the image obtained in step (a) in a memory (buffer in fig. 3);
- c. automatically dialing to a recipient after the first page of the image is stored in step (b) for sending the image to the recipient over a communication line or network (figs. 2 & 3 and col. 14, lines 54-57); and
- d. detecting whether the memory is full and further checking whether the entire fax mail information is received (col. 8, lines 32-38).

Okada, however, does not teach expressly that a message is appended to a document page transmitted last to inform the recipient that there are still additional pages remaining to be received if obtaining the image in step (a) is interrupted.

Satio, the same field of endeavor of the facsimile transmission art, teaches the method for appending an error message to the image data to notify the user that the transmission of the whole document is not completed/finished (col. 5, lines 42-48).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the appending the error message of Saito into the facsimile of Okada.

The suggestion/motivation for doing so would have been to notify the recipient of the incomplete transmission and to further save recording paper by appending the error information along with the image data.

Therefore, it would have been obvious to combine Okada with Saito to obtain the invention as specified in claim 12.

11. With respect to claim 14, Okada teaches the communication method further including the step of monitoring the communication line or network (col. 5, lines 61-65 and col. 7, lines 47-48).

Claims 13, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Okada and Saito as applied to claim 12 above, and further in view of Maniwa U.S. Patent No. 5,768,483.

12. With respect to claim 13, Okada teaches the communication method further including the step of checking whether or not an amount of space available in the image storage means falls within a predetermined value, after the communication control means has dialed the recipient (fig. 3 and col. 8, lines 27-31).

Okada, however, does not teach expressly that the control means for indicating an incompletely stored page number to a user.

Maniwa, the same field of endeavor of the facsimile memory management art, discloses the communication terminal device (facsimile 102 in fig. 1) comprising:

image storage means (page buffer) for storing at least a first page of the image obtained by a scanner (col. 7, lines 51-55); and

communication control means (fax modem 108 in fig. 1) capable of communicating with a recipient over a communication line or network, wherein



control means for indicating an incompletely stored page number to a user when an amount of space available in the insufficiency of the memory occurs (col. 7, lines 51-55 and col. 32, lines 22-32).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the control means for indicating an incompletely stored page number to a user of Maniwa into the communication terminal device of Okada.

The suggestion/motivation for doing so would have been to notify/inform which pages are stored/unstored in the memory to the user when the insufficiency of the memory occurs.

Therefore, it would have been obvious to combine Okada and Saito with Maniwa to obtain the invention as specified in claim 13.

13. With respect to claims 17 and 18, Maniwa teaches the communication method wherein when the device informs the user, the device suggests an alternative transmission method (rescanning of the unsaved pages in col. 32, lines 22-32).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the control means for indicating/informing the fact that one page of an image cannot be stored of Maniwa into the communication terminal device of Okada.

The suggestion/motivation for doing so would have been to notify/inform which pages are stored/unstored in the memory to the user so that user can obtain and transmit the remaining pages to the destination.

Therefore, it would have been obvious to combine Okada and Saito with Maniwa to obtain the invention as specified in claims 17 and 18.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Okada and Saito as applied to claim 12 above, and further in view of Ochiai U.S. Patent No. 5,457,544 (hereinafter Ochiai).

14. With respect to claim 19, the combination of Okada and Saito discloses the communication method of claim 12 but it does not teach expressly that scanning and transmission are performed simultaneously starting from a second page of the document.

Ochiai, the same field of endeavor of facsimile transmission, teaches the method for scanning and transmitting simultaneously starting from a second page of the document (figs 1-3).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to use facsimile apparatus of Ochiai as the transmitting fax 20a of Okada.

The suggestion/motivation for doing so would have been to improve the overall facsimile transmission from the time of the scanning to the receiving of the image data.

Note that, by combining the two references, it would have been obvious to one of ordinary skill in the art to recognize that scanning (scanning of the second page at the transmitting fax 20a) and transmitting (transmitting of data from fax mail apparatus 40 to receiving fax 20b) are performed simultaneously starting from the second page of the document. It would have been obvious since scanning and transmitting at the

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transmitting fax 20a performs simultaneously (fig. 3 of Ochiai) and transmitting (fig. 15 of Okada) to receiving fax 20b performs when the fax mail apparatus 40 receives the first page.

Therefore, it would have been obvious to combine Okada and Saito with Ochida to obtain the invention as specified in claim 19.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Okada, Saito and Maniwa as applied to claim 12 above, and further in view of Ochiai.

15. With respect to claim 20, the combination of Okada, Saito and Maniwa discloses the communication method of claim 12 but it does not teach expressly that scanning and transmission are performed simultaneously starting from a second page of the document.

Ochiai, the same field of endeavor of facsimile transmission, teaches the method for scanning and transmitting simultaneously starting from a second page of the document (figs 1-3).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to use facsimile apparatus of Ochiai as the transmitting fax 20a of Okada.

Arguments analogous to those presented for claim 19, are applicable.

**Conclusion**


16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp  
July 12, 2005

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Examiner  
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